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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,781	09/15/2003	Philip L. Fuchs	P27-053	1498
7590 Henry D. Coleman 714 Colorado Avenue Bridgeport, CT 06605-1601			EXAMINER OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/18/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/662,781

Applicant(s)

FUCHS ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-9, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-9, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/15/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

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The Status of Claims

Claims 3-9 and 12-13 are pending.

Claims 4-9 and 12-13 are rejected.

Claim 3 is objected.

DETAILED ACTION

1. Claims 3-9 and 12-13 are under consideration in this Office Action.

Priority

2. It is noted that this application claims a benefit of 60/410,421 (09/13/2002).

Drawings

3. The drawings filed on 09/15/2003 are accepted by the examiner.

Claim Objections

Claim 3 is objected to because of the following informalities:

In claim 3, the following chemical names have still contained heterocyclic ring structures in them:

"

(1R, 2R, 3R, 4S, 7R)-6-Benzenesulfonyl-2,4-dimethyl-8-oxabicyclo[5.1.0]oct-5-en-3-ol;

(1S, 2R, 3R, 4S, 7S)-6-Benzenesulfonyl-2,4-dimethyl-8-oxabicyclo[5.1.0]oct-5-en-3-ol;

(1R, 2S, 3R, 4S, 7R)-(6-Benzenesulfonyl-2,4-dimethyl-8-oxabicyclo[5.1.0]oct-5-en-3-yloxy)-tert-butyl dimethylsilane;

(1S, 2S, 3R, 4S, 7S)-(6-Benzenesulfonyl-2,4-dimethyl-8-oxabicyclo[5.1.0]oct-5-en-3-yloxy)-tert-butyl dimethylsilane;

"

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The examiner will examine only the "non-heteroaromatic group" under the restriction requirement. This implies that any limitations unrelated to the Group II must be taken out from the claims. Appropriate correction is required.

Election/Restrictions

Applicant's election with traverse of Group I (non-heterocyclic compounds only), namely Claims 3-9 and 12-13 on 1/25/07 is acknowledged. Group II (heterocyclic compounds only) is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the nonelected Group, thereby being no allowable generic or linking claim.

Applicants' arguments are as followed:

- a. The examiner will be required to search 3 classes and subclasses for the elected invention of Group I, whereas the examination of Group II will add only one class/subclass to be searched; therefore, it would not be unduly burdensome; in conclusion, applicants request that the examiner should withdraw the restriction requirement with respect to the claims 3-9 and 12-13.

In response to applicants' argument regarding the restriction, regardless of how few classes (3 or 4) and their subclasses the examiner has to search for the application, the search is a burden since they are unrelated to each other even though applicants think one more class to be examined in addition to the classes to which the Group I may be belonged. This is a well-known fact that each class may contain at least 10,000 patents to be reviewed, whereas each subclass may contain at least 1,000 patents to be reviewed. The search is unduly burdensome to the examiner if there are more than one class and one subclass due to the time constraint for the prosecution of each application. As applicants have already acknowledged that there are at least 3 or 4 distinct, unrelated, different classes belonged to the present invention, there is no relation among them.

Furthermore, M.P.E.P. Section 808.02 gives legitimate reasons for the Examiner to insist on restriction such as the case of separate classification, which indicates that "each distinct subject has attained recognition in the art as a separate subject for the inventive effort, and also a separate field of search."

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-8 and 12 and their dependent claims are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 4-7, and 12, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5-6 recite the

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broad recitation, an oxidizing agent, and the claim also recites preferably a peroxide oxidizing agent, which is the narrower statement of the range/limitation.

In the present instance, claim 12 recites the broad recitation, a blocking group, and the claim also recites preferably a silyl-containing blocking group, which is the narrower statement of the range/limitation. The examiner recommends to add the narrow limitations to the dependent claims.

In claims 5-6, the term "including" is recited. This expression is vague and indefinite because the skilled artisan in the art could not figure out what is excluded.

Therefore, an appropriate correction is required.

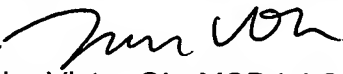
In claims 5-8, the terms "in steps" is recited. This expression is vague and indefinite because the skilled artisan in the art could not figure out what and how the steps are specified. Therefore, an appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Taylor Victor Oh, MSD,LAC
Primary Examiner
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4/13/07